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OFFICE OF PETITIONS

In re Application of :
John Macdonough, Brian Lovejoy, and Joel :
McCleary :
Application No. 09/923,479 :
Filed: August 6, 2001 :
Attorney Docket No. 13413-002001 :
Title: CONCENTRATED KAVALACTONE :
BEVERAGE COMPOSITIONS :

DECISION REFUSING STATUS
UNDER 37 C.F.R. §1.47(a)

This is in response to the petition under 37 C.F.R. 1.47(a)¹, filed March 13, 2002.

The above-identified application was filed on August 6, 2001, identifying John Macdonough, Brian Lovejoy, and Joel McCleary as joint inventors. On September 13, 2001, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted" (Notice), requiring an executed oath or declaration in compliance with 37 C.F.R. §1.63, and a surcharge for its late filing. This Notice set a two-month period for reply.

In reply, applicant filed the instant petition (and fee), a declaration executed by inventors Lovejoy, and McCleary. To make timely this reply, a four-month extension of time was requested.

¹A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$130;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application;
- (3) a statement of the last known address of the non-signing inventors;
- (4) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review;
- (5) proof that the non-signing inventor refuses to sign the oath or declaration after having been presented with the application papers if the inventor refuses to sign, or proof that diligent efforts have been made to locate the non-signing inventor if he or she cannot be found, and;
- (6) a declaration which complies with 37 CFR §1.63.

Petitioner has further included a statement of facts from an attorney of record.

Petitioner has stated on the record that he sent a copy of the declaration to signing inventor Lovejoy on October 1, 2001, requesting that each of the three joint inventors execute the document. On December 13, 2001, he sent a "reminder letter" to signing inventor Lovejoy. On three occasions, petitioner e-mailed the two signing inventors regarding "the papers". On March 5, 2002, signing inventor Lovejoy responded that the "formal papers" had been forwarded to the non-signing inventor. Petitioner states that since March 5, 2002, his attempts to contact the signing inventors via telephone or e-mail have been unsuccessful, and the non-signing inventor has not provided an executed declaration.

Petitioner has met requirements (1), (2), (3), and (6) above.

It is not clear whether petitioner is alleging that the address of the non-signing inventor is unknown, or that the non-signing inventor has refused to sign, as the petition is silent as to this point.

Assuming petitioner is asserting that the correct address of the inventor is not known, Petitioner has failed to meet requirement (5) above. There here is no indication that Rule 47 applicant attempted to verify the non-signing inventor's address or to determine his forwarding address, and to send the application papers to that address for consideration by non-signing inventor MacDonough². No mention is made as to any search done for the non-signing inventor. If attempts to obtain a forwarding address or to locate the non-signing inventor by other means such as through E-mail, telephone, or the Internet continue to fail, then applicant will have provided the necessary proof required under 37 C.F.R. §1.47 that the inventor cannot be reached. Details of the efforts to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person with first hand knowledge of the details. Applicant should submit documentary evidence such as the results of an E-mail or Internet search.

Assuming petitioner is asserting that the non-signing inventor has refused to sign, petitioner has failed to meet requirements (4) and (5) above.

Regarding the fourth requirement above, petitioner has not shown that a *complete* copy of the application was sent to the non-signing inventor. Petitioner states that a two letters were sent to one of the non-signing inventor's, the first of which was accompanied only by the declaration. This establishes that the Rule 47 applicant did not present the non-signing inventor with a copy of the entire application. Where a refusal of the inventor to sign the application papers is alleged, the Office requires the petitioner to establish that a bona fide attempt was made to mail a complete copy of the application, which entails the specification, claims, drawings, and oath or declaration.³ As only the declaration was sent to a party other than the non-signing inventor, the fourth requirement has not been met. On renewed petition, it should be established that a complete copy of the application was sent to the non-signing inventor.

² See MPEP 409.03(d).

³ See MPEP 409.03(d).

Furthermore, the language cited makes it clear that it is inventor Lovejoy, and not the petitioner, who claims to have forwarded the "formal papers"⁴ to the non-signing inventor. As such, the petitioner does not have firsthand knowledge concerning this event. On renewed petition, the petitioner should first have a complete copy of the application sent to the non-signing inventor, and then submit a statement from a party having first-hand knowledge of this event.

Regarding the fifth requirement above, it follows that since it has not been shown that a complete copy of the application was sent to the inventor, one cannot refuse to sign something which one has not seen. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed⁵.

For these reasons, the petition under 37 C.F.R. §1.47(a) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.47(a)."

The reply to this letter may be submitted by mail^{6, 7}, hand-delivery⁸, or facsimile⁹.

The application file will be retained in the Office of Petitions for two (2) months.

Telephone inquiries should be directed to Petitions Attorney Paul Shanowski at (703) 305-0011.



Paul Shanowski
Attorney
Office of Petitions
United States Patent and Trademark Office

⁴ This must refer to the declaration, as the petitioner has established that the other portions of the application were not sent to the non-signing inventor.

⁵ *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

⁶ Commissioner for Patents, Box DAC, Washington, DC 20231.

⁷ Note: as of May 1, 2003, the mailing address for addressing correspondence to the Office will change to:
United States Patent and Trademark Office, PO Box 1450, Alexandria, VA, 22313-1450.

⁸ Office of Petitions, 2201 South Clark Place, Crystal Plaza 4, Suite 3C23, Arlington, VA 22202.

⁹ (703) 308-6916, Attn: Office of Petitions.